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**BARNES & THORNBURG LLP**  
Attorneys at Law

**FAX COVER SHEET**

DATE: July 27, 2006

TO: Examiner Gay Spahn

TELECOPY NO.: 571-273-8300

Company: U.S. Patent &amp; Trademark Office

FROM: Gregory S. Cooper

Phone: 260-425-4660

NUMBER OF PAGES (INCLUDING THIS COVER SHEET): 6

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Customer No.: 23641

Application No.: 10/656699

Confirmation

No.: 8589

Filing Date: September 4, 2003

Group Art

Unit: 3673

Examiner

Name: Gay Spahn

Attorney

Docket No.: 20794/82667

First Named

Inventor: Gruber, Loren R

Title: LANDSCAPING CHANNEL LINER APPARATUS

Re: Request for Reconsideration of Finality of the Rejections

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**REQUEST PURSUANT TO MPEP § 706.07(d)  
EXPEDITED PROCEDURE  
GROUP ART UNIT 3673**

**BARNES & THORNBURG LLP**

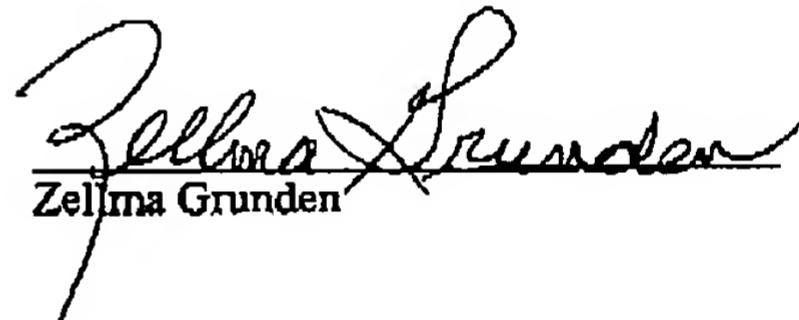
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**PATENT APPLICATION  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Customer No.:	23641	}
Application No.:	10/656699	}
Confirmation No.:	8589	}
Filing Date:	September 4, 2003	}
Group Art Unit:	3673	}
Examiner Name:	Gay Spahn	}
Attorney Docket No.:	20794/82667	}
First Named Inventor:	Graber, Loren R	}
Title:	LANDSCAPING CHANNEL LINER APPARATUS	}

**Certificate Under 37 CFR 1.8(a)**  
I hereby certify that this correspondence is being facsimile transmitted to Examiner Gay Spahn, United States Patent and Trademark Office; Fax No. (571) 273-8300.

on July 27, 2006



Zellma Grunden  
Zellma Grunden

**TRANSMITTAL FORM**

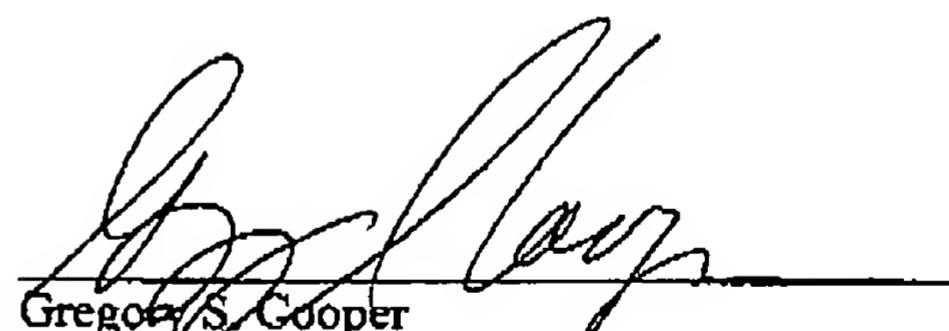
(to be used for all correspondence after initial filing)

**ENCLOSURES (check all that apply)**

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Affidavits/declaration(s)
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Extension of Time Request
<input type="checkbox"/> Amendment/Response	<input type="checkbox"/> Express Abandonment Request
<input type="checkbox"/> After Final	<input type="checkbox"/> Information Disclosure Statement

- Certified Copy of Priority Document(s)
- Response to Missing Parts/Incomplete Application
  - Response to Missing Parts under 37 CFR 1.52 or 1.53
- Drawing(s)
- Licensing-related Papers
- Petition
- Petition to Convert to a Provisional Application
- Power of Attorney, Revocation Change of Correspondence Address
- Terminal Disclaimer
- Request for Refund
- CD, Number of CD(s) \_\_\_\_\_
- After Allowance Communication to Group
- Appeal Communication to Board of Appeals and Interferences
- Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
- Proprietary Information
- Status Letter
- Other Enclosure(s)  
(please identify below):
  - (a) Request for Reconsideration of Finality of the Rejections (3 pages)
  - (b) Fax Cover Sheet (1 page)
  - (c) \_\_\_\_\_
  - (d) \_\_\_\_\_

Remarks:



\_\_\_\_\_  
Gregory S. Cooper  
Reg. No. 40,965  
(260) 423-9440

Date: July 27, 2006

JUL 27 2006

**REQUEST PURSUANT TO MPEP § 706.07(d)  
EXPEDITED PROCEDURE  
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APPARATUS }

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on July 27, 2006

  
Zelma Grunden

**REQUEST FOR RECONSIDERATION OF FINALITY OF THE REJECTIONS**

Commissioner of Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant MPEP § 706.07(d), the undersigned respectfully requests the finality of the Office Action mailed June 28, 2006, be withdrawn. The Examiner's citation of Ter Horst (European Patent Publication No. 0 276515) against Claims 8-13 and 15-19 constitutes a new ground of rejection that was neither necessitated by an amendment of the claims, nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR § 1.97(c). See MPEP § 706.07(a).

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On July 26, 2006, the undersigned received a voice mail message from Patricia Engle, the assigned Supervising Patent Examiner for the above-identified application, stating she believed maintaining the finality of the Office Action is proper because the amendment to Claim 1 was more than what was originally presented. Respectfully, this argument is irrelevant to the finality of the Office Action. The Ter Horst reference at issue was not cited against Claim 1.

The Examiner's reason for citing Ter Horst was to provide support for the Examiner's rejection of the claimed "removable portions" and "selectively removable portion." This precise subject matter has appeared in the case since its original filing. Specifically, rejected Claims 9, 12, 13, and 17 against which Ter Horst was cited, are all claims that were originally filed. Moreover, Claims 10, 11, 15, 16, 18, and 19 received only nominal amendments. For example, Claims 10 and 11 simply changed the words "the" to "a" and "comprising" to "comprises," respectively. The only changes made to Claims 15, 16, 18, and 19 were either to their dependencies or preamble. The dependencies needed to be changed because the "selectively removable portions" from Claim 14 were added to Claim 8 and Claim 14 was canceled. Since Ter Horst is being cited against originally claimed subject matter, this reference should have appeared in the first Office Action, not introduced in the fifth Office Action.

It is wholly improper to finally reject originally filed claims, or even nominally amended claims for that matter, using a newly cited reference. This application was pulled from appeal precisely because the prior cited art and arguments failed to anticipate or make obvious these originally presented or nominally amended claims. The withdrawal of the appeal by the USPTO is *prima facia* evidence that Ter Horst is required to demonstrate either anticipation or obviousness.<sup>1</sup> Consequently, citing Ter Horst against claims as originally filed, as well as only nominally amended claims, introduces a new round of rejection that was neither necessitated by Applicants' amendment of the claims, nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR § 1.97(c). Accordingly, the undersigned respectfully requests withdrawal of the finality of this Office Action.

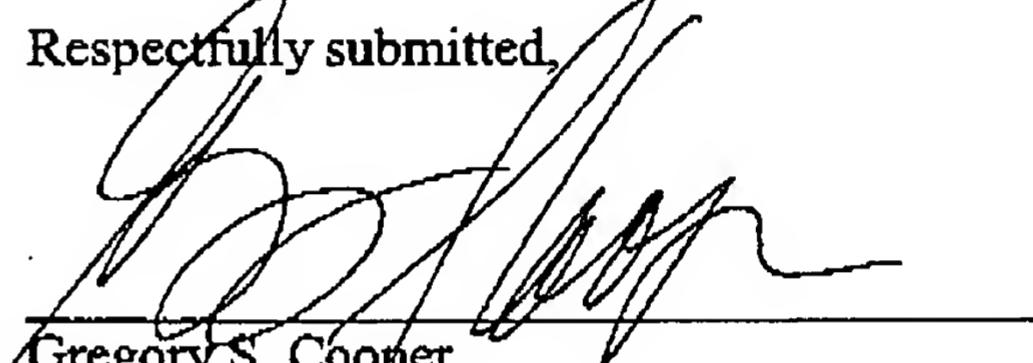
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<sup>1</sup> The undersigned makes no concession that either Ter Horst alone or in combination with other references do, in fact, anticipate or render obvious the claimed invention. Rather, the undersigned is merely restating the Patent Office's position with regard to Ter Horst and other references.

In addition, pursuant MPEP § 710.06, because the undersigned notified the Patent Office of the error on July 21, 2006, i.e., within one month of the mailing date of the Office Action, the undersigned respectfully requests that the time period for the non-final Office Action be reset.

If there are any questions or comments, please feel free to contact the undersigned directly.

Respectfully submitted,



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Gregory S. Cooper  
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Direct Line (260) 425-4660